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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,192

07/07/2006

Fredrick Michael Vernon

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CLARK & BRODY

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Alexandria, VA 22314

EXAMINER

GRAHAM, CHANTEL LORAN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

09/28/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,192	<b>Applicant(s)</b> VERNON, FREDRICK MICHAEL	
	<b>Examiner</b> CHANTEL GRAHAM	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,10,11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,10,11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed 8/11/2010 has been entered and fully considered.
2. Claims 1, 7 and 14 have been amended.
3. New claim 20 is supported by the specification as originally filed.
4. Claims 1, 3-5, 7, 10-11 and 14-20 are pending and have been fully considered.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 3-5, 7, 10-11 and 14-20 are rejected under 35 USC 103 (a) as being obvious over SIPPEL ET AL. (US PATENT 3795556), in view of VAN GILDER ET AL. (US PATENT 2771458) and as evidence by “COMMERICAL KEROSENE” NOV 1998 and RAM ET AL. (INTRINSIC VISCOSITY OF POLYMER SOLUTIONS) . Hereby referred to as SIPPEL, VAN GILDER, “COMMERICAL KEROSENE” and RAM.

Regarding claims 1, 4-5, 7 and 10-11:

SIPPEL teaches the composition and method of a gelled (**thickening**) composition that comprises liquid hydrocarbon (**liquid hydrocarbons**) fuels such as JP-4 and JP-5 and mixtures thereof (**paraffin and kerosene**); and gelling agents such as polyisobutylene (**medium to high molecular weight polymer**) (**branched chain alkene**) (col. 2 lines 5-27; and EXAMPLES I-X; see also claim 1). SIPPEL also teaches that the composition has improved incendiary characteristics e.g., ability to increase burning time and better dispersion on the target (col. 1 ln 54-56); therefore the Examiner has given “incendiary” the broadest interpretation to include “capable of causing fire”, thereby meeting the claimed limitations **wherein the thickened liquid hydrocarbon fuel oil provides improved adhesion to and absorption of fuel on charcoal and enhanced burning time and burn rates**, and burden shifts to Applicants to establish evidence to the contrary or evidence of criticality.

SIPPEL is silent to the properties relating to the claimed flashpoint of kerosene, or that the kerosene is low odor and the molecular weight of polyisobutylene; however these properties are inherently taught by “COMMERICAL KEROSENE” and RAM. The reference establishes that the claimed properties of kerosene can have a flashpoint in the range of 37-65 degrees C (see pg 2 physical properties of “COMMERICAL KEROSENE”) and can be a **low odor kerosene**, one skilled in the art could recognized that the properties are the same (i.e. flash point at 65 degrees C for low odor kerosene); and polyisobutylene can have a range of molecular weights of  $1.1 \times 10^6$  to  $6.6 \times 10^6$  (pg 60, paragraph EXPERIMENTAL of RAM).

The primary reference teaches a composition that contains the claimed components, with the exception of the claimed properties. The claimed specific properties of the

kerosene having a flash point greater than or equal to 62 degree C and that the polymer has a molecular weight in the range of  $1.4 \times 10^6$  to  $2.0 \times 10^6$  are known in the art and are clearly shown by the secondary references and therefore the use thereof is well within the level of ordinary skill in the art because the primary reference implies that any JP-5, which is known to be kerosene, can be used and polyisobutylene is used as the gelling agent (col. 2 ln 10-20). In other words, the use of any kerosene and polyisobutylene is obvious to the skilled artisan, as shown by the secondary references.

The examiner acknowledges that the teaching references are not related to the subject matter of the primary reference but the examiner has only used these references to establish that the claimed properties of kerosene can have a flashpoint in the range of 37-65 degrees C (see pg 2 physical properties of "COMMERICAL KEROSENE") and polyisobutylene can have a range of molecular weights of  $1.1 \times 10^6$  to  $6.6 \times 10^6$  (pg 60, paragraph EXPERIMENTAL of RAM); such properties are known in the art. In addition, "products of identical compound can not have mutually exclusive properties." A compound and its properties are inseparable. Therefore, if the prior art teaches the identical compound, the properties applicant discloses and/or claims are necessarily present. See *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963) ("From the standpoint of patent law, a compound and all its properties are inseparable.").

Again, "COMMERICAL KEROSENE" and RAM are considered teaching reference, not a modifying reference. See MPEP 2112.

**Regarding claims 3 and 15:**

SIPPEL does not explicitly teach that the kerosene has a concentration of 90 to <100% by weight and the polymer has a concentration of up to 5% by weight; however

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VAN GILDER does. VAN GILDER discloses solutions of rubbery polymers (**polymer in solid form**) of high molecular weight and to the production of these solutions which are homogenous and lump free; in which the polymer may be present in solution less than or more than 1% (col. 1 ln 15-25). VAN GILDER also discloses that the polymer may be dissolved in wax (**paraffin**) prior to being diluted in lubricating oils (**paraffin polyolefin polymers**) (col. 2 ln 59-68). VAN GILDER discloses the use of any liquid hydrocarbon fuel can be used instead of lubricating oils (col. 3 ln 36-50), such as kerosene (col. 3 ln 42); and the use of any rubbery polymer such as polyisobutylene (col. 3 ln 47). The solutions produced are useful for many purposes such as adhesives, impregnating materials, dipping or spreading cements, binders when mixed with wood floor, cork, etc. They are also useful as waterproofing materials, coating compositions, and the like (**use as a barbecue lighting fuel**) (col. 3 ln 57-61). However, applicant is reminded that intended use has been continuously held not to be germane to determining the patentability of a composition claim (see MPEP 2111.02).

Although VAN GILDER does not specifically teach the concentration of the kerosene, this reference does in fact teach the concentration of polymer present in solution (see disclosure above) and it is the examiners position that the concentration of polymer being less than or greater than 1% would purport that the concentration of the kerosene would be less than 100% and burden is upon applicants to show evidence otherwise, thereby meeting the claimed limitations of claims 3 and 15. In view of this data, the examiner's position is that the ranges overlap or encompass the claimed ranges. "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

Having the prior art references before the inventors at the time the invention was made it would have been obvious for a skilled artisan to modify the process and composition of SIPPEL by incorporating the process and composition of VAN GILDER by using kerosene as the dilute or liquid hydrocarbon of the polymer and paraffin blend if so desired, the motivation to do so as disclosed in VAN GILDER that it would be obvious to make such modifications because any liquid hydrocarbon fuel and rubbery polymer may be used in composition if so desired. Although the property of barbecue lighting fuel is not disclosed in SIPPEL and VAN GILDER, these solutions generally impart more than one property or function to the composition as taught in VAN GILDER. It has been held that obviousness is not rebutted by merely recognizing additional advantages or latent properties present in the prior art composition. Further, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd.Pat. App. & Inter. 1985)

**Regarding claims 16-19:**

Modified SIPPEL teaches gelling agents such as polyisobutylene (**polyolefin polymer**) are used in the composition (**medium to high molecular weight polymer**) (**branched chain alkene**) (refer to rejection above).

**Regarding claim 20:**

Modified SIPPEL teaches that the composition has improved incendiary characteristics e.g., ability to **increase burning time and better dispersion on the target** (col. 1 ln 54-56); and in view of VAN GILDER discloses the use of any liquid hydrocarbon fuel can be used instead of lubricating oils (col. 3 ln 36-50), such as kerosene (col. 3 ln 42);

and the use of any rubbery polymer such as polyisobutylene (col. 3 ln 47). The solutions produced are useful for many purposes such as **adhesives**, impregnating materials, dipping or spreading cements, **coating compositions**, binders when mixed with wood floor, cork, etc.

### ***Response to Arguments***

8. Applicant's arguments filed 8/11/2010 have been fully considered but they are not persuasive.

Applicant argues “*A prima facie case of obviousness is not established against claim 20. Claim 20 is an application of the fuel oil made by claim 1 to charcoal for lighting purposes. No new matter is introduced by this claim since the specification expressly describes this use, see page 1, the last five lines.*

*Claim 20 raises the question of whether the composition of Sippel, even if modified according to the teachings of Commercial Kerosene, RAM, and Van Gilder, would be used in the claimed manner. The question must be answered in the negative since Sippel is concerned with a self igniting incendiary material, useful for flamethrowers and the like.”*

SIPPEL teaches that the composition has improved incendiary characteristics e.g., ability to **increase burning time and better dispersion on the target** (col. 1 ln 54-56); and in view of VAN GILDER discloses the use of any liquid hydrocarbon fuel can be used instead of lubricating oils (col. 3 ln 36-50), such as kerosene (col. 3 ln 42); and the use of any rubbery polymer such as polyisobutylene (col. 3 ln 47). The solutions produced are useful for many purposes such as **adhesives**, impregnating materials, dipping or spreading cements, **coating compositions**, binders when mixed with wood floor, cork, etc. The Examiner has given “incendiary” the broadest interpretation to include “capable of causing fire”, thereby meeting the claimed limitations, and burden shifts to Applicants to establish evidence to the contrary or evidence of criticality. Also, a



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reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozdek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421. A prima facie case of obviousness may be made when chemical processes have very close methods and similar utilities. "An obviousness rejection based on similarity in chemical methods and function entails the motivation of one skilled in the art to make a claimed process, in the expectation that processes having similar methods will produce similar products." *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979) See *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991) See also MPEP § 2144.08.

The office has clearly established a prima facie case of obviousness as outlined above (i.e. all the claimed components are taught by the references in the claimed processes) and now burden shifts to applicants to establish evidence otherwise or evidence of criticality and they have not shown that any additional methods would be expected to be of similar processes to the evidence of record. This burden is shifted to applicants once a prima facie case of obviousness has been established and as outlined above, one has been established. The Examiner is of the position that the claimed invention would have been obvious because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. In view of the teachings as set forth above, it is

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the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

Applicant argues “*A prima facie case is not established against claim 14 Claim 14 is revised to clarify that what is being claimed is a barbeque lighting fuel. This revision raises two issues, the first being whether the Examiner must treat the claim preamble as a limitation and, if so, whether such a fuel is obvious from the cited prior art.*”

Examiner respectfully disagrees for at least the reasons stated above. Regarding claim 14, intended use has been continuously held not to be germane to determining the patentability of a composition claim (see MPEP 2111.02). If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim); *STX LLC. v. Brine*, 211 F.3d 588, 591, 54 USPQ2d 1347, 1350 (Fed. Cir. 2000) (holding that the preamble phrase “which provides improved playing and handling characteristics” in a claim drawn to a head for a lacrosse stick was not a claim limitation). Compare *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)

As set forth above, the preamble language “a barbeque lighting fuel” is a statement of intended use which carries no patentable weight in composition claims. (see MPEP 2111.02)

Applicant argues “The Examiner has committed error in the interpretation of Commercial Kerosene and RAM on the issue of inherency. In the rejection, the Examiner seems to be saying that both of Commercial Kerosene and RAM disclose the claimed kerosene and polymer such that the invention is made by merely taking a kerosene that is encompassed by the teachings of Commercial Kerosene and taking the polymer of RAM and using it in Sippel. This is error since the Examiner has misinterpreted the teachings of Commercial Kerosene and RAM and this misinterpretation taints the rejection such that it must be either remade or withdrawn.”

Examiner respectfully disagrees for at least the reason set forth above. Additionally, SIPPEL was relied on to teach the composition and method of a gelled composition that comprises liquid hydrocarbon fuels such as JP-4 and JP-5 and mixtures thereof (**paraffin and kerosene**); and gelling agents such as polyisobutylene (see rejection above). “COMMERICAL KEROSENE” was relied on as a teaching reference to establish that the claimed properties of kerosene can have a flashpoint in the range of 37-65 degrees C (see rejection above). RAM was relied on as a teaching reference to establish that the claimed properties of polyisobutylene can have a range of molecular weights of  $1.1 \times 10^6$  to  $6.6 \times 10^6$ . “COMMERICAL KEROSENE” and RAM are considered teaching reference, not a modifying reference. See MPEP 2112.

However the Examiner’s rationale to support a conclusion that the claims would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).

The office has clearly established a prima facie case of obviousness as outlined above (i.e. all the claimed components are taught by the references in the claimed processes) and now burden shifts to applicants to establish evidence otherwise or evidence of criticality and they have not shown that any additional methods would be expected to be of similar processes to the evidence of record. This burden is shifted to applicants once a prima facie case of obviousness has been established and as outlined above, in which one has been established. In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

Applicant argues *“The Examiner has committed error in interpreting the teachings of Sippel and in the reasoning used for modifying Sippel. The mere fact that the kerosene and polymer may be derived from the teachings of Commercial Kerosene and RAM does not mean that their mere existence is grounds for use in Sippel. Why choose a kerosene and polymer with the particular attributes of claim 1. Sippel provides no reason to do so. Commercial Kerosene does not teach the combination of low odor and the specific flashpoint. RAM does not point to the need for a specifically defined molecular weight range.”*

Examiner respectfully disagrees for at least the reasons above. In addition, regarding claims 1, 4-5, 7 and 10-11, “COMMERICAL KEROSENE” and RAM are considered teaching reference, not a modifying reference. See MPEP 2112. Regarding claims 3 and 15-20, SIPPEL in view of VAN GILDER provided reasoning to modify SIPPEL as stated in the above rejection; having the prior art references before the inventors at the time the invention was made it would have been obvious for a skilled artisan to modify the process and composition of SIPPEL by incorporating the process and composition of VAN GILDER by using kerosene as the dilute or liquid hydrocarbon of the polymer and paraffin blend if so desired, the motivation to do so as disclosed in VAN GILDER that it would be obvious to make such modifications because any liquid hydrocarbon fuel and

rubbery polymer may be used in composition if so desired. Although the property of barbecue lighting fuel is not disclosed in SIPPEL and VAN GILDER, these solutions generally impart more than one property or function to the composition as taught in VAN GILDER. It has been held that obviousness is not rebutted by merely recognizing additional advantages or latent properties present in the prior art composition. Further, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd.Pat. App. & Inter. 1985)

Applicant argues “The Examiner has committed error in asserting that kerosene and a polymer having the claimed function can be used in Sippel with no change in their respective functions and that such a use yields only predictable results. Here, the Examiner is using the decision in KSR to support the allegation of obviousness. However, the Examiner's assumption that there is no change in respective functions and the contemplated modification of Sippel would only yield predictable results in not based on any objective facts. Where is the basis in fact for the assumption that there is no change in the performance of the incendiary composition of Sippel when a different kerosene and polymer are used in Sippel?”

Examiner respectfully disagrees for at least the reason above. In addition, SIPPEL teaches that the composition has improved incendiary characteristics e.g., ability to **increase burning time and better dispersion on the target** (col. 1 ln 54-56); and in view of VAN GILDER discloses the use of any liquid hydrocarbon fuel can be used instead of lubricating oils (col. 3 ln 36-50), such as kerosene (col. 3 ln 42); and the use of any rubbery polymer such as polyisobutylene (col. 3 ln 47). The solutions produced are useful for many purposes such as **adhesives**, impregnating materials, dipping or spreading cements, **coating compositions**, binders when mixed with wood floor, cork, etc. The Examiner has given “incendiary” the broadest interpretation to include “capable of causing

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fire”, thereby meeting the claimed limitations, and burden shifts to Applicants to establish evidence to the contrary or evidence of criticality. Also, a reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozgek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421. A prima facie case of obviousness may be made when chemical processes have very close methods and similar utilities. "An obviousness rejection based on similarity in chemical methods and function entails the motivation of one skilled in the art to make a claimed process, in the expectation that processes having similar methods will produce similar products." *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979) See *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991) See also MPEP § 2144.08.

The office has clearly established a prima facie case of obviousness as outlined above (i.e. all the claimed components are taught by the references in the claimed processes) and now burden shifts to applicants to establish evidence otherwise or evidence of criticality and they have not shown that any additional methods would be expected to be of similar processes to the evidence of record. This burden is shifted to applicants once a prima facie case of obviousness has been established and as outlined above, one has been established. The Examiner is of the position that the claimed invention would have been obvious because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than

predictable results to one of ordinary skill in the art. In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

Applicant argues “The Examiner's rejection is unclear concerning the reliance on Van Gilder and this lack of clarity mandates at least remaking of the rejection.” The Examiner has further clarified the paragraph in which Applicant may have been unclear “The Examiner acknowledges that the **teaching references** (instead of previously stated “secondary reference”) are not related to the subject matter of the primary reference but the examiner has only used these references to establish that the claimed properties of kerosene can have a flashpoint in the range of 37-65 degrees C (see pg 2 physical properties of “COMMERICAL KEROSENE”) and polyisobutylene can have a range of molecular weights of  $1.1 \times 10^6$  to  $6.6 \times 10^6$  (pg 60, paragraph EXPERIMENTAL of RAM); such properties are known in the art. In addition, “products of identical compound can not have mutually exclusive properties.” A compound and its properties are inseparable. Therefore, if the prior art teaches the identical compound, the properties applicant discloses and/or claims are necessarily present. See *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963) (“From the standpoint of patent law, a compound and all its properties are inseparable.”).

Again, “COMMERICAL KEROSENE” and RAM are considered teaching reference, not a modifying reference. See MPEP 2112.

Applicant argues “The Examiner's rejection of claims 3 and 15 is in error since the required reasoning to modify Sippel is missing. The arguments made above are reiterated here for the rejection of claims 3 and 15. In essence, the Examiner is saying that since the ratio of kerosene to polymer of claims 3 and 15 is disclosed in Van Gilder, it is obvious to employ such a ratio in Sippel. This rejection is improper since the Examiner is merely identifying a feature in the prior art but failing to identify the articulated reasoning required by the

*Supreme Court in KSR to say why use the ratio of Van Gilder in Sippel. Therefore, a prima facie case of obviousness is not established against claims 3 and 15.”*

Examiner respectfully disagrees from the reason set forth above. In addition, the Examiner maintains the position that having the prior art references before the inventors at the time the invention was made it would have been obvious for a skilled artisan to modify the process and composition of SIPPEL by incorporating the process and composition of VAN GILDER by using kerosene as the dilute or liquid hydrocarbon of the polymer and paraffin blend if so desired, the motivation to do so as disclosed in VAN GILDER that it would be obvious to make such modifications because any liquid hydrocarbon fuel and rubbery polymer may be used in composition if so desired.

### ***Conclusion***

9. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANTEL GRAHAM whose telephone number is (571)270-5563. The examiner can normally be reached on M-Th 8:00-5:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Marcheschi can be reached on 571-272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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